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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,387	02/18/2004	J. Michael Rivera	022050-000100US	4345
20350	7590	09/29/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BATTULA, PRADEEP CHOUDARY	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,387

Applicant(s)

RIVERA ET AL.

Examiner

Pradeep C. Battula

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 8, 14 and 20 is/are rejected.
- 7) ☒ Claim(s) 2-6, 9-13, 15-19 and 21-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/11/05 & 7/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osamu (JP 07299955 A) in view of Fujii et al (Fujii, European Publication 0331841 A2).

In regards to Claim 1, Osamu discloses a method of attaching a hologram film to printed matter, comprising: printing a pattern on a substrate 3 with UV curable ink 4. Osamu further discloses that the holographic film 8 is bonded to the UV curable ink by some sort of glue (Paragraph 12; Figure 2, Items 3, 4, 8; Abstract).

Osamu does not disclose that the holographic film is placed over said pattern.

Fujii discloses UV curable ink for use in printing which has properties of good adhesion upon curing (Page 2, Lines 5 – 16). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace Osamu's ink 4 and glue with Fujii's curable ink in order to reduce the amount of materials required and increase the durability of the printed matter (Page 2, Lines 5 – 16).

Furthermore, as stated above, with the new ink the glue layer can be disposed of and the holographic film 8 can be placed directly over the ink since it is the only material remaining. Fujii discloses that the adhesion of the ink goes into effect when curing

Art Unit: 3722

occurs therefore; it is inherent that curing the ink would be the last step in order to adhere the holographic film to the ink.

In regards to Claim 14, Osamu discloses a security label comprising: a substrate 3; a pattern of UV cured ink on said substrate 4; and a holographic film 8 where the film is bonded to the ink with some form of glue (Paragraph 12; Figure 2, Items 3, 4, 8).

Osamu does not disclose that the holographic film is placed over said pattern of ink.

Fujii discloses UV curable ink for use in printing which has properties of good adhesion upon curing (Page 2, Lines 5 – 16). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace Osamu's ink 4 and glue with Fujii's curable ink in order to reduce the amount of materials required and increase the durability of the printed matter (Page 2, Lines 5 – 16).

Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osamu (JP 07299955 A) in view of Yin et al (Yin, U.S. 5,318,816) and in further view of Bolt (U.S. 5,360,501).

In regards to Claim 7, Osamu discloses a method of attaching a hologram film to printed matter comprising: printing a pattern on a substrate 3 with ink 4 with a curable adhesive layer 4a.

Osamu does not disclose placing a transparent UV curable adhesive layer over said pattern; placing a holographic film over said adhesive layer; and curing said UV

Art Unit: 3722

curable adhesive layer with UV light wherein said curing causes said holographic film to stick to said adhesive layer.

Yin teaches the use of a transparent adhesive layer in a security document containing holograms (Column 4, Lines 15 – 21). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use transparent ink with assemblies containing holograms in order to prevent the ink from interfering with holographic and ink layers.

Yin does not disclose that the transparent adhesive is UV curable; placing a holographic film over aid adhesive layer; and curing said UV curable adhesive layer with UV light wherein said curing causes said holographic film to stick to said adhesive layer.

Furthermore, applicant has failed to disclose the criticality of using a transparent UV curable adhesive nor has applicant disclosed the criticality of using a transparent adhesive.

Bolt teaches a process of laminating a hologram to a substrate using UV curable ink (Column 5, Lines 23 – 35). Therefore it would have been obvious to a person having ordinary skill in the art to use a UV curable adhesive with transparent properties in order to create an adhesive that prevents discoloring of a hologram (Column 5, Lines 23 – 35 of Bolt) and does not interfere with the ink layers of a hologram.

The use of an UV curable adhesive in Osamu's invention does not require the use of Osamu's glue to hold the holographic film to the assembly. Therefore once UV curable ink 4 is placed on the substrate 3 (Osamu, Paragraph 12; Figure 2, Items 3, 4) then the UV curable adhesive can be placed over the ink as disclosed by applicant.

Art Unit: 3722

Considering said adhesive does not reach full adhesive properties until it is cured, it is inherent to place the holographic film 8 (Osamu, Paragraph 12; Figure 2, Item 8), the only remaining component, over the adhesive and then to cure the adhesive with UV light causing the holographic film 8 to stick to said adhesive layer.

In regards to Claim 8, as applied to Claim 7, Osamu further discloses the ink is UV curable ink (Paragraph 12).

In regards to Claim 20, Osamu discloses a security label comprising: a substrate 3; an ink pattern printed 4 on said substrate; a transparent UV cured adhesive 4a; a holographic film over said adhesive layer, said film adhering to said adhesive layer with a glue layer (Paragraph 12; Figure 2, Items 3, 4, 8).

Osamu does not disclose that the UV cured adhesive is transparent and that it is separate from the ink pattern.

Yin teaches the use of a transparent adhesive layer in a security document containing holograms (Column 4, Lines 15 – 21). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use transparent ink with assemblies containing holograms in order to prevent the ink from interfering with holographic and ink layers.

Yin does not disclose that the transparent adhesive is UV curable; placing a holographic film over aid adhesive layer; and curing said UV curable adhesive layer with UV light wherein said curing causes said holographic film to stick to said adhesive layer.

Art Unit: 3722

Furthermore, applicant has failed to disclose the criticality of using a transparent UV curable adhesive nor has applicant disclosed the criticality of using a transparent adhesive.

Bolt teaches a process of laminating a hologram to a substrate using UV curable ink (Column 5, Lines 23 – 35). Therefore it would have been obvious to a person having ordinary skill in the art to use a UV curable adhesive with transparent properties in place of Osamu's glue in order to create an adhesive that prevents discoloring of a hologram (Column 5, Lines 23 – 35 of Bolt) and does not interfere with the ink layers of the hologram.

Allowable Subject Matter

Claims 2 – 6, 9 – 13, 15 – 19, and 21 – 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3722

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
September 15, 2006


MONICA CARTER
SUPERVISORY PATENT EXAMINER